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09/864,723	05/23/2001	Natasha P. Hixon	4842US	2791

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EXAMINER

CHOI, STEPHEN

ART UNIT	PAPER NUMBER
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3724

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/864,723
Filing Date: May 23, 2001
Appellant(s): HIXON ET AL.

MAILED
OCT 19 2005
Group 3700

Brick G. Power
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 27 July 2005 appealing from the Office action mailed 13 December 2004.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

No evidence is relied upon by the examiner in the rejection of the claims under appeal.

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 12-13, 16, and 24 are rejected under 35 U.S.C. 102(b) as being anticipated by Lo (US 5,617,785).

Lo discloses all the recited elements of the invention including:

- a) a first member including an uninterrupted planar die receiving surface (at 40) and a die retaining element associated with the die receiving surface (40), the die retaining element being configured to secure a planar surface of a substantially planar die (80) to the die receiving surface;
- b) a second member including an uninterrupted planar sheet supporting surface oriented to oppose the die receiving surface (at 90);
- c) handles associated with the first and second members so as to facilitate movement of at least one member of the first and second members toward the other of the first and second members (30, 120).

Regarding claim 13, the element 40 is magnet. Regarding claim 24, the die receiving surface (at 40) is unbounded.

Claims 31-32 and 37 are rejected under 35 U.S.C. 102(b) as being anticipated by Mercorelli (US 3,372,482).

Mercorelli discloses all the recited elements of the invention including:

- d) an uninterrupted, planar die receiving surface (inner surface of a channel 18);
- e) a die retaining element associated with the die receiving surface (at 18);
- f) a substantially planar die (21);

g) a sheet supporting surface (at 20);

h) handles (14, 15).

Regarding claim 32, side surfaces of 21 which fit into the channel 18 are uninterrupted and planar, and are completely supported by the die receiving surface (at 18).

Claims 31-34 and 36-37 are rejected under 35 U.S.C. 102(a) as being anticipated by WO 00/51533 (hereinafter '533).

'533 discloses all the recited elements of the invention including:

i) an uninterrupted, planar, unbounded die receiving surface (end surface of a threaded shaft at 14);

j) a die retaining element associated with the die receiving surface (threaded shaft at 14);

k) a substantially planar die (16);

l) an uninterrupted and planar sheet supporting surface (18);

m) handles (20).

Regarding claim 32, an inner end surface of 16 receiving the threaded shaft is uninterrupted and planar, and are completely supported by the die receiving surface (the end surface of a threaded shaft at 14). Regarding claim 36, 18b.

Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Lo (US 5,617,785) in view of Fink et al. (US 4,574,693).

Lo discloses the invention substantially as claimed except for mechanically securing the planar die. Fink discloses means for mechanically securing a planar die to

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a die receiving surface (76). It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the device of Lo to mechanically secure the planar die to the die receiving surface as taught by Fink as an alternative means for securing the die.

Claims 15 and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lo (US 5,617,785) in view of Sabin (US 5,172,622).

Lo discloses the invention substantially as claimed except for a cushioning element. Sabin discloses a cushioning element (22). It would have been obvious to one having ordinary skill in the art at the time the invention was made to employ a cushioning element as taught by Sabin on the device of Lo in order to minimize wear on an edge of the die.

Claims 25-28 and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lo.

Lo discloses the invention substantially as claimed except for the die receiving surface configured to completely support a planar back side of a substantially planar die. Figure 5 of Lo appears to show the die being sized to extend beyond a periphery of the die receiving surface. However, one having ordinary skill in the art would have been motivated to provide a different size of the die for a different embossing operation (e.g., a die having size to be completely supported by the die receiving surface) since such a modification would have involved a mere change in the size of a component. A change in size is generally recognized as being within the level of ordinary skill in the art. In re

Rose, 105 USPQ 237 (CCPA 1955). It is noted that the proposed modification would not change the principle of operation of Lo' s device.

Claim 35 is rejected under 35 U.S.C. 103(a) as being unpatentable over '533 in view of Benson et al. (US 5,660,105).

'533 discloses the invention substantially as claimed except for the die retaining element being one of a magnetic and a magnetically-attractable material. Benson teaches use of a magnet to retain a die. It would have been obvious to one having ordinary skill in the art at the time the invention was made to employ a magnet as taught by Benson on the device of '533 in order to facilitate attachment of the die.

(10) Response to Argument

Response to arguments with respect to the reference to Lo

Appellants contend that Lo fails to disclose an uninterrupted, planar sheet supporting surface because Lo lacks any description that either the element 40 or the element 60 includes a surface that supports a sheet of material into which a die is to be forced and the element 90 of Lo is an embossing die which is not planar. Furthermore, appellants contend that Lo fails to expressly state that the element 30 may be used as a handle and Lo also does not teach the handles configured to be held by and operated with a hand of a user.

It appears that appellants are stating that all embossing dies are non-planar. The statement is incorrect. The element 90 of Lo does show an uninterrupted, planar surface into which a die is to be forced and is capable of supporting a sheet. Furthermore, the examiner has also provided an example of a commonly known

embossing die that has a surface that is uninterrupted and planar in the previous office action mailed on 13 December 2004 (US 2,005,340 to Jaffin et al.) in order to rebut the appellant's statement. Moreover, it is also noted that an upper surface of the element 60, which is certainly planar, can be considered as the sheet supporting surface as claimed since the upper surface is also capable of directly or indirectly capable of supporting a sheet. In addition, Lo does teach handles as claimed since a hand of a user can hold the element 30 and/or 120, and these handles are associated with the first and second members.

Response to arguments with respect to the reference to Mercorelli

Appellants contend that Mercorelli does not expressly or inherently describe a member with a sheet supporting surface because members 11 and 12 are both configured to receive dies. Furthermore, Mercorelli does not disclose a die receiving surface that is planar and uninterrupted because of bosses 25. Appellants further contend that Mercorelli does not teach the die receiving surface being configured to receive and completely support an uninterrupted, planar surface of the die.

Claim 31 calls for "a sheet supporting surface oriented to oppose said die receiving surface". Mercorelli does disclose a sheet supporting surface (an upper or front surface of the element 20) which is capable of supporting a sheet and is positioned to oppose a die receiving surface (at 18). Moreover, a surface at the element 18 includes an uninterrupted, planar die receiving surface (inner surface at 18) as well as the bosses 25. In addition, side surfaces of the die 21, which are uninterrupted and

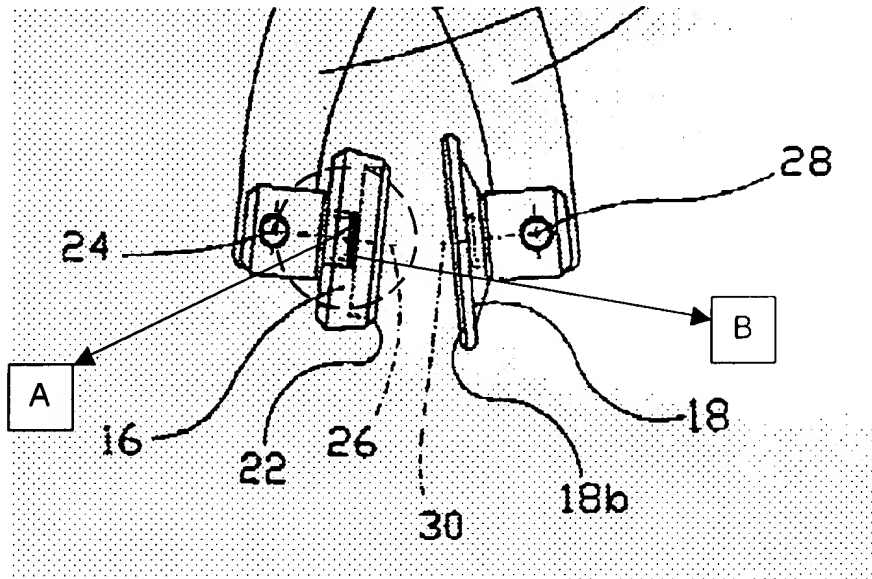
planar, fit into the element 18, thus meets the limitations “an uninterrupted, planar die receiving surface...said die retaining element configured to secure a substantially planar die...” as recited in claim 31. It is also noted that the claims do not preclude the die receiving surface having other elements. Furthermore, the phrase “configured to receive and completely support” recited in claim 32 does not necessarily mean that the entire portion of the die receiving surface is required to be in direct engagement with the surface of the die. It merely requires the die surface being supported by the die receiving surface. For example, the weight of the die is completely supported by the die receiving surface. With respect to appellant’s argument based on a raised portion of Mercorelli, it is noted that the appellant’s invention also includes a raised cutting edge.

Response to arguments with respect to the reference to Andersen (WO 00/51533)

Appellants contend that Andersen fails to disclose a member that includes an uninterrupted, planar die receiving surface and a die retaining element that is “configured to secure a substantially planar die to said die receiving surface”. Appellants further argue that Andersen does not teach a surface that is configured to “receive and completely support an uninterrupted planar surface of [a] substantially planar die”.

The examiner respectfully disagrees. Andersen does disclose (see figure below) an uninterrupted, planar die receiving surface (at A) and a die retaining element (B) associated with the die receiving surface (see page 7, lines 21-24). Figure 1 of Andersen clearly shows an end surface at A being uninterrupted and planar in order to

receive and completely support an uninterrupted, planar surface within a cavity receiving the threaded shaft at the substantially planar element 16.



Response to arguments with respect to the 103(a) rejection over Lo

Appellants contend that one of ordinary skill in the art would not have been motivated to modify the device of Lo to provide two or more handles.

The examiner respectfully points out that there are no rejections that propose to modify the device of Lo to provide two or more handles. Lo's device alone teaches two handles as set forth above.

Appellants further contend that Lo fails to suggest a member that has a die receiving surface, which is configured to completely support a planar back side of a substantially planar die.

As stated above, at least the weight of the die including the back side is completely supported by the die receiving surface. However assuming appellants are

arguing that the entire surface on the planar back side of the die is in a direct contact with the die receiving surface, it is the examiner's position that it would have been obvious to one of ordinary skill in the art to change the size of the die for a different embossing operation since such a modification would not change the principle of operation of Lo's device. Furthermore, appellant's argument regarding the dies 80 and 90 would have to include recesses in the back sides is unclear. Lo does not teach any recesses on the back sides of the elements 80 and 90.

Appellants also appear to repeat their arguments regarding that Lo does not teach a substantially planar surface that supports a sheet of material and the die 90 is not substantially planar, and Lo also does not teach handles associated with the first and second members.

As mentioned above, appellants appear to state that all embossing dies are non-planar. However, the examiner respectfully disagrees. Although the element 90 of Lo does appear to show an uninterrupted, planar surface into which a die is to be forced and is capable of supporting a sheet, the examiner has also provided an example of a commonly known embossing die that has a surface that is uninterrupted and planar in the previous office action mailed on 13 December 2004 (US 2,005,340 to Jaffin et al.). Again, it is also noted that an upper surface of the element 60, which is certainly planar, could have been considered as the sheet supporting surface as claimed since the upper surface is also capable of directly or indirectly capable of supporting a sheet. Furthermore, Lo does teach handles as claimed since a hand of a user can hold the element 30 and/or 120 and 30 are associated with the first and second members.

Response to appellant's statement regarding the secondary consideration of nonobviousness

Appellants appear to argue that a declaration filed with the appeal brief should be entered and considered since the examiner has been informed of the availability of evidence showing secondary indicia of nonobviousness on at least two occasions (April 15, 2004 and June 15, 2004). Furthermore, appellants state that the declaration could not have been submitted at an earlier date since the rejections under 35 U.S.C. 103(a) were not raised until the final office action.

From the appellant's statement, it appears that appellants had an opportunity to file a declaration for consideration at least prior to filing of the appeal brief. However, appellants failed to do so. Since appellants have failed to show good and sufficient reasons why the declaration was not earlier presented (i.e. at least prior to filing of the appeal brief), the declaration will not be admitted. See MPEP 1211.02.


(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

sc


STEPHEN CHOI
PRIMARY EXAMINER

Conferees:


Joseph Hail


Boyer Ashley